Remarks

Amendments to the Claims

The amendments to the claims to not add new matter. Claim 1 is amended to recite that binding between the test compound and the purified 14189 polypeptide is determined using an antibody which selectively binds to the 14189 polypeptide. Claim 9 also is amended to recite an antibody which selectively binds to the 14189 polypeptide. Such antibodies and their use to detect kinase polypeptides are disclosed, *inter alia*, in paragraph [0015]. See also paragraphs [0090] – [0096].

Claim 3 is amended to recite a host cell which is transfected with a recombinant expression vector which expresses a 14189 polypeptide and contacting the host cell with a test compound under conditions in which the vector expresses the 14189 polypeptide. Paragraph [0011] and section III, beginning with paragraph [0099], support this amendment.

Rejection Under 35 U.S.C. § 102(e)

Claims 1-4, 6-9, 11-19, 21-27, and 29-35 are rejected under 35 U.S.C. § 102(e) as anticipated by Meyers.[1] Claims 2, 7, 8, and 21-27 are canceled. Applicants respectfully traverse the rejection of claims 1, 3, 4, 6, 9, 11-19, and 29-35.

Anticipation under 35 U.S.C. § 102 requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Meyers does not meet this standard.

[1] Meyers, U.S. Patent 6,656,698.

First, Meyers does not disclose a purified 14189 polypeptide as recited in claims 1, 4, 6, and 13-19. The present specification defines "purified" as, *inter alia*, "substantially free of other cellular material." Paragraph [0043]. Meyers does not disclose a 14189 polypeptide which is substantially free of other cellular material.

Second, claim 1 as amended and dependent claims 4, 6, and 13-19 recite that binding between the test compound and the purified 14189 polypeptide is determined using an antibody which selectively binds to the 14189 polypeptide. Claim 9 as amended and dependent claims 11, 12, and 29-35 as amended also recite an antibody which selectively binds to the 14189 polypeptide. Meyers does not teach an antibody which selectively binds to a 14189 polypeptide, much less its use to detect binding between a test compound and a purified 14189 polypeptide.

Third, Meyers does not disclose a 14189 polypeptide immobilized on a solid surface, as recited in claim 11.

Fourth, Meyers does not disclose a host cell which is transfected with a recombinant expression vector which expresses a 14189 polypeptide as recited in claim 3.

Meyers does not disclose each element of claims 1, 3, 4, 6, 9, 11-19, and 29-35 and therefore does not anticipate these claims. Please withdraw the rejection.

Non-Statutory Obviousness-Type Double Patenting Rejection

Claims 1-4, 6-9, 11-19, 21-27, and 29-35 are rejected as obvious over claims 1-10 of Meyers. Claims 2, 7, 8, and 21-27 are canceled. Applicants respectfully traverse the rejection of claims 1, 3, 4, 6, 9, 11-19, and 29-35.

A non-statutory obviousness-type double patenting rejection is analogous to an obviousness rejection under 35 U.S.C. § 103 except that the disclosure of the cited patent is not

considered prior art. *In re Braithwaite*, 379 F.2d 594, 600, footnote 4, 154 U.S.P.Q. 29, 34, footnote 4 (C.C.P.A. 1967). A double patenting analysis therefore parallels an analysis under 35 U.S.C. § 103(a). *In re Braat*, 937 F.2d 589, 592, 19 U.S.P.Q.2d 1289, 1291-92 (Fed. Cir. 1991).

The U.S. Patent and Trademark Office bears the initial burden of establishing a *prima facie* case of obviousness based on the results of the factual inquiries under *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). M.P.E.P., 8th ed., § 2142. It remains black letter law that obviousness requires at least a suggestion of all of the features in a claim. See *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003). Moreover, as the Supreme Court recently stated, "there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l v. Teleflex Inc.*, 550 U.S. 398, 418 (2007), citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

As an initial matter, the question of whether an obviousness-type double patenting rejection is correct cannot be answered without properly construing each set of claims: "Double patenting is altogether a matter of what is claimed." *General Foods Corp. v. Studiengesellschaft Kohle GmbH*, 972 F.2d 1272, 1277, 23 U.S.P.Q.2d 1839, 1343 (Fed. Cir. 1992). It is a fundamental rule of claim construction that every limitation is material and that what is claimed is what is defined by the claim as a whole. *Id.* at 1280, 23 U.S.P.Q.2d at 1845.

The pending claims are directed to methods of identifying compounds which bind to a polypeptide (a "14189 polypeptide") which has a kinase activity. Claims 1-10 of Meyers are directed to methods of identifying compounds which modulate the activity of and/or bind to a polypeptide (described in the specification as a "12832 polypeptide") which has a kinase activity.

The 14189 and 12832 polypeptides are entirely different.[2] Each of claims 1, 3, 4, 6, 9, 11-19, and 29-35 recites determining whether the test compound binds **to the 14189 polypeptide**. There is no legal or scientific reason why claims which recite one type of kinase molecule could be *prima facie* obvious over claims which recite an entirely different polypeptide.

Please withdraw the rejection.

Respectfully submitted,

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[2] Evidence that the two polypeptides are different was provided with the response filed July 19, 2006 and is not repeated here.